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IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: ROHDE, Wolfgang et al. Conf.: 1520
Appl. No.: 09/485,131 Group: 1655
Filed: February 4, 2000 Examiner: JOHANNSEN, D.
For: THE USE OF PRIMERS FOR UNIVERSAL
FINGERPRINT ANALYSIS

SMALL ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents
Washington, DC 20231

January 18, 2002

Sir:

Transmitted herewith is a Reply to Restriction/Election Requirement in the above-identified application.

- ☒ Applicant claims small entity status under 37 C.F.R. § 1.27.
- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☒ Petition for three (3) month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$460.00 for the extension of time.
- ☐ No fee is required.
- ☒ Check(s) in the amount of \$460.00 is(are) enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

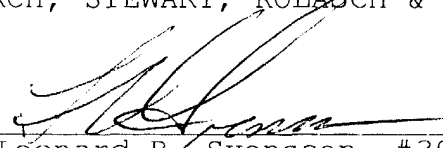
Appl. No. 09/485,131

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


Leonard R. Svensson, #30,330

LRS/lmt
0147-0193P

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Attachments

(Rev. 09/27/01)

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D.C. 20231 on: January 18, 2002
(Date of deposit)

BIRCH, STEWART, KOLASCH & BIRCH, LLP


(Signature)

January 18, 2002
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

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APPLICANTS: ROHDE, Wolfgang et al. CONF.:1520
SERIAL NO.: 09/485,131 GROUP: 1655
FILED: February 4, 2000 EXAMINER: JOHANNSEN, D.
FOR: THE USE OF PRIMERS FOR UNIVERSAL FINGERPRINT
ANALYSIS

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

January 18, 2002

Sir:

In response to the Examiner's Office Action dated September 19, 2001, the period for response having been extended three (3) months to January 19, 2002, the following remarks are respectfully submitted in connection with the above-identified application.

The Examiner has required a restriction between the claims of Groups I – IV. This requirement is respectfully traversed. Reconsideration and withdrawal thereof are requested. Applicants submit that the Examiner's restriction requirement is improper for two reasons. First of all, the Examiner urges that the inventions of Groups I – IV do not show a "special" technical feature because the publication to Rohde allegedly discloses "several of the primers recited in Tables 1 and 2 and discloses the use of these primers in fingerprinting." But Rodhe only describes primers roughly by their ability to bind to the sequence of Copia-like elements. No single primer is described in the publication by it's sequence. Thus it is not seen how the Examiner can properly assert that the Rodhe publication anticipates the present claims.

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Secondly, Applicants submit that the Examiner has not properly construed or applied the unity of invention standard applicable under PCT Rule 13, as is clear from a review of the international phase of this application. Since this is the national phase of a PCT application, unity of invention must be analyzed under PCT Rule 13. The Examiner will note that no unity of invention objection was raised during the international phase of this application, which applied the unity of invention standard of PCT Rule 13. An international application which complies with those unity of invention requirements must then be accepted by all of the designated and elected offices, including the USPTO, since Article 27(1) of the Patent Cooperation Treaty does not permit any national law or national office to require compliance with different regulations relating to the contents of the international application. Thus the U.S. application must be examined for Unity of Invention consistent with the Patent Cooperation Treaty, not just by giving verbal assent to the unity of invention standard by mere reference to the PCT Rule, but rather an actual application of the standard. See *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. VA 1986). In this case, proper application of the unity of invention standard means that the application of PCT Rule 13 by the USPTO should be consistent with the application by the PCT Examiner of the same rule for the same subject matter. This means that the Examiner's restriction requirement is improper, in that all of the claims in the application should be searched and examined together.

Therefore, Applicants submit that all of the claims of Groups I-IV (i.e. claims 1-15) should be examined in this application.

However, in order to be fully responsive to the Office Action, if the Examiner maintains the full scope of the restriction requirement, then Applicants elect to prosecute the claims of Group I, i.e. claims 1-11.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application and the required fee of \$460.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

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